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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,190	09/17/2003	Denis Ghesquiere	291621US0	9335

22850 7590 02/21/2008  
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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GILLESPIE, BENJAMIN

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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02/21/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
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<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/667,190		GHESQUIERE, DENIS	
	<b>Examiner</b>		<b>Art Unit</b>	
	BENJAMIN J. GILLESPIE		1796	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thoma et al ('172) and GB 917,450. Thoma et al teach a method for producing a polyurethane elastomer comprising the reaction product of an (A) isocyanate-terminated prepolymer and (B) polyester polyol (Col 1 lines 25-33; col 2 lines 3-15). ‘
2. In particular, patentees explain that (A) is the reaction product of diisocyanate and polyester polyol, which is different from (B), specifically those described in the British Patent 917,450 (Col 2 lines 41-44, 55). GB 917,450 teaches that aliphatic polyester polyol is produced by reacting dicarboxylic acids, such as adipic, sebacic, or glutaric acid with diols such as butanediol and ethylene glycol (GB 917,450, page 2, lines 58-64, 69, 71). Component (B) is a polyester polyol produced by the reaction product of diol such as ethylene glycol, butanediol, or diglycol, and dicarboxylic acids, wherein said dicarboxylic acids contain both (i) aliphatic and (ii) aromatic compounds in a (i):(ii) molar ratio consisting of 1:1 (Col 3 lines 59-62, 68-70, 74-75; col 3 lines 1-4).
3. Important to note is that although patentees teach the aromatic dicarboxylic acid may consist of terephthalic or isophthalic acid, there is no disclosure of orthophthalic acid (Col 3 lines 59-62). Nevertheless it would have been obvious to include orthophthalic acid based on the motivation patentees teach other phthalic acids as suitable aromatic dicarboxylic acids, and

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compounds having the same radicals at different positions on the nucleus are position isomers. Their properties are often so nearly alike as to present difficulties in identification or separation. Ex parte Mowry (POBA 1950) 91 USPQ 219. Furthermore, although patentees do not list orthophthalic acid, it is not definitively precluded from a possible aromatic compound as the listed species are only “examples.”

4. Similarly, regarding the aliphatic dicarboxylic acid, Thoma et al fail to specifically teach sebacic acid, instead only teaching aliphatic dicarboxylic acids such as adipic acid (Col 4 lines 4-5). Nevertheless it would have been obvious to arrive at the claimed composition based on the disclosure of GB 917,450, as previously discussed. GB 917,450 teaches polyesters based on phthalic acid and aliphatic dicarboxylic acids, specifically adipic acid and sebacic acid (Page 2 lines 58-64, 67). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the aliphatic dicarboxylic acid of Thoma et al for the sebacic acid, as GB 917,450 teach it useful in polyesters based on aliphatic and aromatic compounds, and specifically it is a suitable equivalent for adipic acid, and the mere substitution of an equivalent is not an act of invention; where equivalency is known to the prior art, the substitution of one equivalent for another is not patentable, i.e. it would have been obvious. *In re Ruff* 118 USPQ 343 (CCPA 1958).

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thoma et al ('172) and GB 917,45 in view of Lorenz et al ('471). Aforementioned, Thoma et al teach a polyurethane elastomer comprising the reaction product of an aliphatic polyester based NCO terminated polyurethane prepolymer, and aromatic polyester polyol, wherein the resulting

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polyurethane is useful in load bearing applications (Col 4 lines 65-67). However, Thoma et al fail to disclose shoe soles comprising said polyurethane elastomer.

6. Lorenz et al also teach polyurethane elastomers comprising the reaction product of NCO terminated polyester based polyurethane prepolymer, and polyester polyol (Col 1 lines 5-11, 45-56; col 3 lines 54-67; col 4 lines 1-14). In particular the polyesters are based on the reaction products of acids such as sebacic and adipic acid, and low molecular weight diols consist of butanediol, ethylene glycol as well as diethylene glycol. Finally, patentee explains that based on the mechanical behavior of the elastomer as well as chemical resistance, the resulting elastomer is useful in shoe sole construction (Col 10 lines 10-15).

7. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the elastomer of Thoma et al in shoe soles based on the motivation that Thoma et al and Lorenz et al having similar compositions, and the prima facie case of obviousness that rises from the expectation that compounds similar in structure will have similar properties. *In re Gyurik*, 596 F. 2d 1012, 201 USPQ 552 (CCPA 1979).

#### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN J. GILLESPIE whose telephone number is (571)272-2472. The examiner can normally be reached on 8am-5:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be

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reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

B. Gillespie

/Rabon Sergent/  
Primary Examiner, Art Unit 1796